

## **REMARKS**

Claims 1-5 and 7-21 are pending in the application. Claims 11-13 have been withdrawn from consideration. Claims 1-3, 7, 8 and 18-21 have been amended. Favorable reconsideration of the application, as amended, is respectfully requested.

### ***I. REJECTION OF CLAIMS 2 AND 14 UNDER 35 U.S.C. § 102(b) / 103(a)***

Claims 2 and 14 have been rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over McNichols (U.S. Patent No. 6,667,085) as evidenced by Morman (U.S. Patent No. 5,226,992).

Applicants respectfully traverse the rejection for at least the following reasons. Claim 2 has been amended to recite the step of changing an attitude of each cut panel to an attitude that is obtained by a rotation of about 90 degrees with respect to the flow direction *so that the elastic threads extends along a direction perpendicular to the flow direction*. McNichols fails to disclose or suggest feeding an elastic thread between a pair of sheet-like materials along a flow direction of the pair of sheet-like materials so as to obtain a laminate to be the side panels, cutting the laminate to obtain a left cut panel and a right cut panel, and then changing an attitude of each cut panel to an attitude that is obtained by rotation of about 90 degrees with respect to the flow direction so that the elastic thread extends along a direction perpendicular to the flow direction.

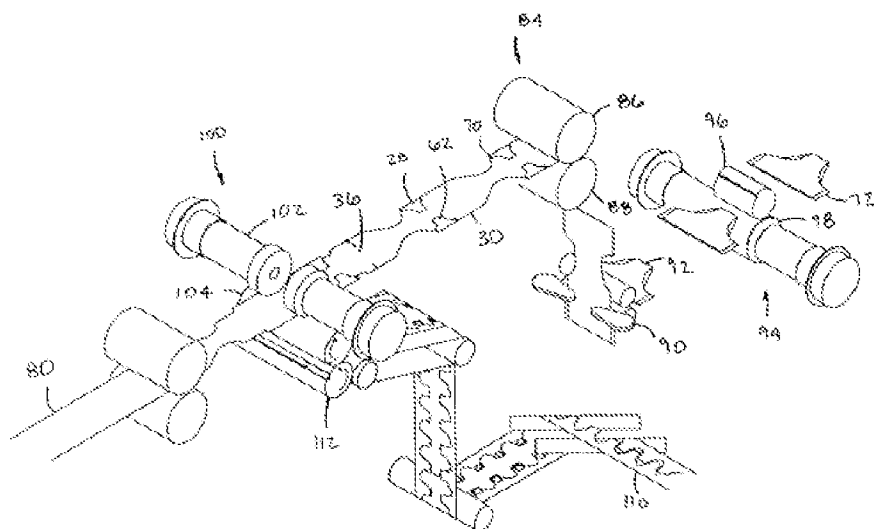


FIG. 1

McNichols discloses changing the direction of the flow of the webs of side panels 110 at the point that the webs are spaced apart. (See Fig. 1 and column 7, lines 4-11.) However, McNichols does not disclose or suggest feeding an elastic thread between a pair of sheet-like materials along a flow direction, cutting the sheet-like material into side panel webs and then changing the direction of the side panels with respect to the flow direction. Because McNichols fails to teach or suggest all of the limitations of claims 2 and 14, the rejection under 35 U.S.C. §102/§103 should be withdrawn.

## **II. REJECTION OF CLAIMS 1, 4, 5 AND 7 UNDER 35 U.S.C. § 103(a)**

Claims 1, 4, 5 and 7 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Durrance et al. (U.S. Publication No. 2002/0002358) as evidenced by Morman (U.S. Patent No. 5,226,992) and further in view of Nakakado et al. (U.S. Publication No. 2004/0035521), Nease et al. (U.S. Patent No. 5,705,013) and Guevara et al. (U.S. Patent No. 6,086,571). The Examiner contends that it would have been obvious to incorporate the elastic web forming method of Nakakado et al. into the method of Durrance et al. because one of ordinary skill would recognize the economic benefits of applying the elastic intermittently as in the method of Nakakado et al. The Examiner further contends that bonding the side panel to the body portion through the non-contractile portion of the panel is well known in the art and would have been obvious to one of ordinary skill, citing Nease et al. (Fig. 1) and Guevara et al. (Fig. 6A) as examples.

Applicants respectfully traverse the rejection for at least the following reasons. Claim 1 has been amended to recite the step of changing an attitude of a pair of cut panels including two of the cut panels adjacent to each other to an attitude that is obtained by a rotation of about 90 degrees with respect to the flow *direction so that the elastic threads extend along the direction perpendicular to the flow direction*.

With regard Nakakado et al. (U.S. Publication No. 2004/0035521, "Publication '521"), Applicants submit herewith the Declaration under 37 C.F.R. §1.132 of co-inventor Masaki Nakakado. Mr. Nakakado is a co-inventor of the presently claimed invention and a co-inventor of Publication '521. Mr. Nakakado states that the relevant

portions described in Publication '521 originated solely with Mr. Nakakado. Inventor Takao Wada and Mr. Nakakado are co-inventors of the other aspects of the invention disclosed and claimed in the present application. Thus the relevant disclosure of Publication '521 was derived from Mr. Nakakado's own work. Accordingly, U.S. Publication No. 2004/0035521 does not qualify as a reference against the presently claimed invention.

Durrance et al. fails to disclose or suggest side panels that are formed by feeding parallel elastic threads between a pair of sheet-like materials, such that the parallel elastic threads are continuous in the flow direction of the sheet-like materials and shrinkable in the flow direction. Furthermore, Durrance et al. fails to disclose or suggest cut panels formed from a laminate that has contractile portions and non-contractile portions wherein the laminate is cut along the non-contractile portion, resulting in a side panel that is made by attaching a pair of cut panels to the main body in the non-contractile portions of the pair of cut panels. Even further, Durrance et al. fails to disclose cutting a laminate to obtain cut panels at the same time the fastening element is cut into two pieces, as recited in claim 5.

Even if one skilled in the art were to combine the teachings of Durrance et al. with the teachings of Nease et al. and Guevara et al., the resulting combination would not include all of the recited features of claims 1, 4, 5 and 7. Therefore, prima facie obviousness cannot be established and the rejection under 35 U.S.C. §103(a) should be withdrawn.

### ***III. REJECTION OF CLAIMS 2 AND 14 UNDER 35 U.S.C. § 103(a)***

Claims 2 and 14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over McNichols (U.S. Patent No. 6,667,085) as evidenced by Morman (U.S. Patent No. 5,226,992) in view of Nease et al. (U.S. Patent No. 5,705,013). It is the Examiner's position that if it is found that McNichols fails to disclose cutting the web in a flow direction to form two laminate webs, it would have been obvious to incorporate the teachings of Nease et al. into the method of McNichols because one of ordinary skill would have recognized the economic advantage of utilizing a zero-scrap method of producing side panels as taught by Nease et al.

Applicants respectfully traverse the rejection for at least the following reasons. As discussed above, claim 2 has been amended to recite the step of changing an attitude of each cut panel to an attitude that is obtained by a rotation of about 90 degrees with respect to the flow direction *so that the elastic thread extends along a direction perpendicular to the flow direction*. McNichols does not disclose or suggest feeding an elastic thread between a pair of sheet-like materials along a flow direction, cutting the sheet-like material into side panel webs and then changing the direction of the side panels with respect to the flow direction. Nease et al. also fails to teach or suggest this claimed feature. Thus, even if there were some motivation to combine the teachings of McNichols with those of Nease et al, the resulting combination would not include all of the features of the method of claim 2. Accordingly, prima facie obviousness cannot be established and the rejection of claims 2 and 14 under 35 U.S.C. §103 should be withdrawn.

#### **IV. REJECTION OF CLAIMS 3, 8-10 AND 15 UNDER 35 U.S.C. § 103(a)**

Claims 3, 8-10 and 15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Olson et al. (U.S. Patent No. 6,645,190) in view of Nease et al. (U.S. Patent No. 5,705,013) and Pohjola (U.S. Patent No. 5,224,405). It is the Examiner's position that it would have been obvious to incorporate the teachings of Nease et al. into the method of Olson et al. because one of ordinary skill would have recognized the economic advantages of utilizing a zero scrap method of producing side panels as taught by Nease et al. It is also the Examiner's position that it would have been obvious to incorporate a known successful method of rotating and placing a discrete side article onto web of material, such as the method of Pohjola, into the method of Olson et al. because such a modification would have been well within his technical grasp.

Applicants respectfully traverse the rejection for at least the following reasons. Claim 3, as amended, recites that the method includes the step of feeding an elastic thread between a pair of sheet-like materials along a flow direction of the pair of sheet-like materials so as to obtain a laminate to be the side panels, *wherein the elastic thread is continuous in the flow direction* of the sheet-like materials and shrinks in the flow direction. Claim 8 now recites that the *laminate comprises parallel elastic threads*

*between a pair of sheet-like materials.* Claims 3 and 8 recite changing an attitude of the first and second cut panels to an attitude that is obtained by a rotation of about 90 degrees with respect to the flow direction and changing an attitude of the third and fourth cut panels to an attitude that is obtained by a rotation of about 90 degrees with respect to the flow direction.

Olson et al. makes no mention whatsoever of the process for making the laminate from which the side panels (34, 134) are formed, the process by which the laminate is cut to form side panels, and the process of attaching two pairs of side panels to the main body (32). Moreover, Olson et al. fails to teach or suggest a method of making a wearable article that includes first making side panels that shrink (stretch) in the flow direction and then attaching those side panels to a main body. Nease et al. also fails to teach or suggest making a wearable article that includes side panels that shrink (stretch) in the flow direction and then attaching those side panels to a main body. Furthermore, none of the cited references Olson et al., Nease et al. and Pohjola teach or suggest a method for producing a worn article the includes side panels formed from a laminate that includes continuous elastic threads between a pair of sheet-like materials. Thus, even if one skilled in the art were to combine the teachings of Olson et al. with those of Nease et al. and Pohjola, the resulting method would not include all of the features of the methods of claims 3 and 8. Accordingly, prima facie obviousness cannot be established, and the rejection of claims 3, 8-10 and 15 under 35 U.S.C. §103 should be withdrawn.

#### **V. REJECTION OF CLAIM 16 UNDER 35 U.S.C. § 103(a)**

Claim 16 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over McNichols (U.S. Patent No. 6,667,085) as evidenced by Morman (U.S. Patent No. 5,226,992), or in the alternative, McNichols (U.S. Patent No. 6,667, 085) as evidenced by Morman (U.S. Patent No. 5,226,992) in view of Nease et al. (U.S. Patent No. 5,705,013) and further in view of Roessler et al. (U.S. Patent No. 5,399,219). It is the Examiner's position that it would have been obvious to incorporate a known method of forming side panel webs with fasteners, such as the method of Roessler, into the

method of McNichols because such a modification would have been within his technical grasp.

Applicants respectfully traverse the rejection for at least the following reasons. As discussed above, claim 2 has been amended to recite the step of changing an attitude of each cut panel to an attitude that is obtained by a rotation of about 90 degrees with respect to the flow direction *so that the elastic threads extends along a direction perpendicular to the flow direction*. McNichols does not disclose or suggest feeding an elastic thread between a pair of sheet-like materials along a flow direction, cutting the sheet-like material into side panel webs and then changing the direction of the side panels with respect to the flow direction. Neither Nease et al. nor Roessler et al. teach or suggest these claimed features. Thus, even if there were some motivation to combine the teachings of McNichols with those of Nease et al. and Roessler et al., the resulting combination would not include all of the recited features of the method of claim 16. Accordingly, prima facie obviousness cannot be established and the rejection of claim 16 under 35 U.S.C. §103 should be withdrawn.

#### **VI. REJECTION OF CLAIM 17 UNDER 35 U.S.C. § 103(a)**

Claim 17 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Olson et al. (U.S. Patent No. 6,645,190), in view of Nease et al. (U.S. Patent No. 5,705,013) and Pohjola (U.S. Patent No. 5,224,405) and further in view of Surprise et al. (U.S. Patent No. 6,174,303). The Examiner contends that it would have been obvious to incorporate the teachings of Surprise et al. into the method of the combined references Olson et al., Nease et al. and Pohjola and use a dual fastening system for the diaper because Surprise et al. teaches that a dual fastening system provides improved diaper fit as well as additional support for the absorbed chassis.

Applicants respectfully traverse the rejection for at least the following reasons. As discussed above, the combination of the teachings of Olson et al., Nease et al. and Pohjola fail to teach or suggest all of the recited features of the method of claim 3, from which claim 17 depends. Surprise et al. fails to cure the deficiencies of the combination of Olson et al., Nease et al. and Pohjola et al. Thus, even if one skilled in the art were to combine the teachings of Olson et al. with those of Nease et al., Pohjola and

Surprise, the resulting method would not include all of the features of the method of claim 17. Accordingly, prima facie obviousness cannot be established, and the rejection of claim 17 under 35 U.S.C. §103 should be withdrawn.

**VII. REJECTION OF CLAIMS 18 AND 20 UNDER 35 U.S.C. § 103(a)**

Claims 18 and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over McNichols (U.S. Patent No. 6,667,085) as evidenced by Morman (U.S. Patent No. 5,226,992), or in the alternative, McNichols (U.S. Patent No. 6,667,085) as evidenced by Morman (U.S. Patent No. 5,226,992) in view of Nease et al. (U.S. Patent No. 5,705,013) and further in view of Nakakado et al. (U.S. Publication No. 2004/0035521). It is the Examiner's position that it would have been obvious to incorporate the elastic web forming method of Nakakado et al. into the method of the combined references McNichols, Morman and Nease et al. because one of ordinary skill would recognize the economic benefits of applying the elastic intermittently as in the method of Nakakado et al.

Applicants respectfully traverse the rejection for at least the following reasons. As discussed above, claim 2 has been amended to recite the step of changing an attitude of each cut panel to an attitude that is obtained by a rotation of about 90 degrees with respect to the flow direction *so that the elastic thread extends along a direction perpendicular to the flow direction*. Claims 18 and 20 depend from claim 2. McNichols does not disclose or suggest feeding an elastic thread between a pair of sheet-like materials along a flow direction, cutting the sheet-like material into side panel webs and then changing the direction of the side panels with respect to the flow direction. As discussed above, Nakakado et al. has been removed as a reference with the Declaration of Mr. Nakakado. Nease et al. does not cure the deficiencies of McNichols. Thus, even if there were some motivation to combine the teachings of McNichols with those of Nease et al., the resulting combination would not include all of the features of the method of claims 18 and 20. Accordingly, prima facie obviousness cannot be established and the rejection of claims 18 and 20 under 35 U.S.C. §103 should be withdrawn.

**VIII. REJECTION OF CLAIMS 19 AND 21 UNDER 35 U.S.C. § 103(a)**

Claims 19 and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Olson (U.S. Patent No. 6,645,190), Nease et al. (U.S. Patent No. 5,705,013) and Pohjola (U.S. Patent No. 5,224,405) and further in view of Nakakado et al. (U.S. Publication No. 2004/0035521). The Examiner contends that it would have been obvious to incorporate the elastic web forming method of Nakakado et al. into the method of the combined references Olson et al., Nease et al. and Pohjola because one of ordinary skill would recognize the economic benefits of applying the elastic intermittently as in the method of Nakakado et al.

Applicants respectfully traverse the rejection for at least the following reasons. Claim 3, from which claims 19 and 21 depend, has been amended to recite that the method includes the step of feeding an elastic thread between a pair of sheet-like materials along a flow direction of the pair of sheet-like materials so as to obtain a laminate to be the side panels, wherein the elastic thread is continuous in the flow direction of the sheet-like materials and shrinks in the flow direction. Claim 3 further recites changing an attitude of the first and second cut panels to an attitude that is obtained by a rotation of about 90 degrees with respect to the flow direction and changing an attitude of the third and fourth cut panels to an attitude that is obtained by a rotation of about 90 degrees with respect to the flow direction.

As discussed above with regard to claim 3, the combination of the teachings of Olson et al., Nease et al. and Pohjola fail to teach or suggest all of the recited features of the method of claim 3, from which claims 19 and 21 depend. Nakakado et al. has been removed as a reference with the Declaration of Mr. Nakakado. Because the combined teachings of Olson et al., Nease et al. and Pohjola fail to disclose all of the claim limitations of claims 19 and 21, prima facie case of obviousness cannot be established. Applicants therefore respectfully request withdrawal of the rejection of claims 19 and 21 under 35 U.S.C. §103.



**IX. CONCLUSION**

Accordingly, claims 1-5, 7-10 and 14-21 are believed to be allowable and the application is believed to be in condition for allowance. A prompt action to such end is earnestly solicited.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

Should a petition for an extension of time be necessary for the timely reply to the outstanding Office Action (or if such a petition has been made and an additional extension is necessary), petition is hereby made and the Commissioner is authorized to charge any fees (including additional claim fees) to Deposit Account No. 18-0988.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

/Mark D. Saralino/

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DATE: April 29, 2010

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Application No: 10/598,028

Case No: YMMRP0108US

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Takao Wada et al.

Application No: 10/598,028

Filing Date: August 16, 2006

For: **WORN ARTICLE AND METHOD FOR PRODUCING THE SAME**

Examiner: Christopher C. Caillouet

Art Unit: 1791

Confirmation No: 9351

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**DECLARATION UNDER 37 C.F.R. §1.132**

Sir:

I, Masaki Nakakado, declare and state that:

I am a citizen of Japan and a co-inventor of the invention disclosed and claimed in the above-identified patent application.

I am a co-inventor of the subject matter disclosed and claimed in U.S. Patent Publication No. 2004/0035521 (Publication '521), published on February 26, 2004.

It is my understanding that the Examiner finds that Publication '521 discloses relevant portions of the presently claimed method: specifically, the steps of supplying an elastic member; stretching the elastic member; placing the stretched elastic member so

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that the elastic member spreads across a plurality of first webs divided in a transport direction; making a part of a second web loose in the transport direction while transporting the second web, thereby forming a loose portion; placing the first webs on which the elastic member is disposed on non-loose portions before and after the loose portion of the second web; and cutting the elastic member between adjacent first webs of the plurality of first webs.

Such relevant portions described in Publication '521 originated solely with me.

Takao Wada and I are co-inventors of other aspects of the invention disclosed and claimed in the present application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: March 23, 2010

中門正毅  
Masaki Nakakado